

Remarks

This Application has been carefully reviewed in light of the Office Action mailed August 8, 2008. Applicants appreciate the Examiner's consideration of the Application. Although Applicants believe all pending claims are allowable over the rejections made by the Examiner without amendment, Applicants have made a clarifying amendment to Claim 1. This amendment is not made in relation to any reference cited by the Examiner and is not considered narrowing. Applicants respectfully request reconsideration and full allowance of all pending claims.

I. Claims 1-16 and 28-38 Recite Patentable Subject Matter

The Examiner rejects Claims 1-16 and 28-38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

With regard to Claims 1-16, the Examiner states the following:

Claim 1 is directed to identifying and monitoring best practices of an enterprise. As the claims are not sufficiently tied to an apparatus, such as a computer, the claim is therefore rejected under 35 U.S.C. 101. . . .
Claims 2-16 . . . are rejected for being dependent upon rejected [claim] 1. .

(*Office Action*, p. 3).

Patentable subject matter is "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35 U.S.C. § 101. The Supreme Court has held, however, that a claim is not a patent eligible "process" under § 101 if it claims "laws of nature, natural phenomenon, [or] abstract ideas." *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981) *citing Parker v. Flook*, 437 U.S. 584, 589 (1978), and *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). In determining whether a process is patent eligible under 35 U.S.C. § 101, the Supreme Court has articulated (and the United States Court of Appeals for the Federal Circuit has recently affirmed) the "machine-or-transformation test." *Benson*, 409 U.S. at 70; *see also In re Bilski*, No. 08/833,892, 2008 WL 4757110, at *11, (Fed. Cir. October 30, 2008). Under the "machine-or-transformation test" a claim directed to a process is patent eligible if the claim either "is tied to a particular machine" or "transforms an article into a different state or thing." *See Bilski*, 2008 WL

4757110 at *11 *citing Benson*, 409 U.S. at 70. Thus, for a claim directed to a process to be patent eligible under 35 U.S.C. § 101, the claim must either be tied to a particular machine or the claim must transform an article into a different state or thing. *Id.*

Claim 1, as amended, is directed to a “process for identifying and monitoring one or more best practices of an enterprise” that comprises:

- defining a set of criteria for determining whether each of a plurality of practices of the enterprise qualify as a best practice of the enterprise;
- receiving a practice profile of a particular practice of the enterprise, the practice profile comprising information associated with the particular practice and relating to one or more of the criteria; and
- performing, ***using one or more computer systems***, a maturity assessment process to determine, based on a comparison between the practice profile for the particular practice and the set of criteria, whether the particular practice qualifies as a best practice of the enterprise and, if the particular practice so qualifies, assigning a best practice maturity level to the particular practice, the best practice maturity level defining to what degree the particular practice qualifies as a best practice of the enterprise.

Thus, at least the emphasized language of Claim 1 makes clear that the method recited in Claim 1 is tied to a computer system. Because a computer system is a “machine,” the method of Claim 1 is “tied to a particular machine.” Therefore, the method recited in Claim 1 constitutes statutory subject matter under 35 U.S.C. § 101 according to the applicable case law.

For at least these reasons, Applicants respectfully submit that independent Claim 1 and its dependent claims meet the requirements of 35 U.S.C. § 101 and respectfully request that the 35 U.S.C. § 101 rejections of these claims be withdrawn.

With regard to Claim 28-38, the Examiner states:

As to Claim 28, software per se consists of non-patentable subject matter. Computer programs claimed as computer listings per se. i.e., the descriptions or expressions of programs, are no physical “things.” They are neither components nor statutory processes, as they are not “acts” being performed. MPEP 2106.01. . . . Claims . . . 29-38 are rejected for being dependent upon rejected [claim] . . . 28 . . .

(*Office Action*, p. 3).

The Examiner cites no authority actually supporting the proposition that claims directed to software are not a process, a machine, a manufacture, or a composition of matter. In contrast to the Examiner's assertion, The United States Court of Appeals for the Federal Circuit has stated that 35 U.S.C. § 101 "explains that an invention includes 'any new and useful process, machine, manufacture or composition of matter.' Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes." *Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338-39 (Fed. Cir. 2005) (citations omitted) (emphasis added). Furthermore, the Federal Circuit recently stated that "we decline to adopt a broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court," clearly rejecting the type of *per se* exclusion on software apparently suggested by the Examiner. *Bilski*, 2008 WL 4757110 at *11 n.23. These unequivocal statements by the Federal Circuit clearly condone claims directed to software.

Moreover, the very chapter of the M.P.E.P. cited by the Examiner as the basis for rejecting Claims 28-38 states that "functional descriptive material consists of data structures **and computer programs** which impart functionality when employed as a computer component." M.P.E.P. ch. 2106.01 (emphasis added). "When functional descriptive material [*i.e.*, computer programs, according to above-cited portion of the M.P.E.P.] **is recorded on some computer-readable medium**, it becomes structurally and functionally interrelated to the medium **and will be statutory in most cases** since use of technology permits the function of the descriptive material to be realized." *Id.* (emphasis added). This portion of the M.P.E.P. makes clear that the M.P.E.P. contemplates and, in fact, authorizes claims directed to software embodied in a computer-readable medium and operable to perform certain functions. Because Claims 28-38 are directed to "[s]oftware for identifying and monitoring one or more best practices of an enterprise, the software being embodied in computer-readable media . . . ," the manner in which the claims have been drafted is clearly contemplated by the M.P.E.P. as being statutory.

For at least these reasons, Applicants respectfully submit that independent Claim 28 and its dependent claims meet the requirements of 35 U.S.C. § 101 and respectfully request that the 35 U.S.C. § 101 rejections of these claims be withdrawn.

II. The Claims are allowable over *Balz*

The Examiner rejects Claims 1-8, 10, 13, 15, 17-22, 24, 26, 28-33, and 37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0018519 by Balz et al. ("*Balz*"). Applicants respectfully traverse these rejections and discuss independent Claim 1 as an example.

"A claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. ch. 2131. In addition, "[t]he identical invention must be shown in *as complete detail as contained in the . . . claim*." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); *see also* M.P.E.P. ch. 2131. Furthermore, "[t]he elements must be arranged *as in the claim* under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) (emphasis added); M.P.E.P. ch. 2131. As illustrated below, *Balz* does not appear to disclose, either expressly or inherently, each and every limitation recited in Claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases.

At a minimum, the cited portions of *Balz* fail to disclose, teach, or suggest the following limitations recited in Claim 1:

- performing a maturity assessment process to determine, based on a comparison between the practice profile for the particular practice and the set of criteria, whether the particular practice qualifies as a best practice of the enterprise and, if the particular practice so qualifies, assigning a best practice maturity level to the particular practice, the best practice maturity level defining to what degree the particular practice qualifies as a best practice of the enterprise.

As allegedly disclosing these limitations, the Examiner cites paragraphs 43 and 50 of *Balz*. (*Office Action*, p.4). Paragraph 43 of *Balz* states that the process vitality index (PVI) assessment scheme comprises a number of predefined categories, each category containing a number of criteria that indicate the degree of fulfillment of the underlying category. The criteria comprise YES/NO questions each assigned a value according to the answer to the question. *Id.* The sum of values assigned to the answers to each of the criteria questions for a category yield a subscore for the category, wherein the sum of the subscores provides a final score for the underlying process. *Id.* In addition, paragraph 50 of *Balz* states that “the proposed scheme provides multiple criteria ordered into categories . . . wherein [the] categories characterize different process maturity levels.”

Beyond citing the above-described portions of *Balz*, the Examiner has provided little in the way of guidance as to what portion of *Balz* specifically discloses, teaches, or suggests each of the above-recited limitations of Claim 1. Thus, Applicants are forced to speculate as to which particular element discussed in *Balz* the Examiner is attempting to equate with the “best practice maturity level[s]” recited in Claim 1. It appears that the Examiner is attempting to equate the “categories” disclosed in *Balz* with the “best practice maturity level[s]” of Claim 1. Further analysis of *Balz* reveals that the categories of the PVI assessment scheme are organized in phases, with progression from one phase to the next being dependent on achieving a predefined sum of category subscores (*see Balz*, paragraph 41; Fig. 6; Figs. 7A-C). If that predefined minimum score is not achieved, the evaluation simply ends. *Id.* In other words, the maturity level of a process being assessed in *Balz* appears to be a mere byproduct of the degree of progression through the assessment scheme, apparently meaning that an assessment process that terminates at step 5, for example, is more mature than an assessment process that terminates at step 4. Because any maturity level associated with a process apparently is only a byproduct of degree of progression through the assessment scheme, it appears that each process will have an associated maturity level tied to the category at which the process terminated due to a failure to achieve the predefined minimum score required to proceed (as paragraph 50 states that “categories characterize different process maturity levels”).

Thus, in *Balz* there is no independent “determin[ing] whether the particular practice qualifies as a best practice of the enterprise” followed by “assigning a best practice maturity level to the particular practice” as recited in Claim 1 because, in *Balz*, every process will have an associated maturity level tied to the degree of progression through the assessment with no independent determination of whether the process being analyzed qualifies for the assignment of a maturity level followed by the assignment of the maturity level. Thus, at a minimum, *Balz* does not disclose, teach, or suggest “determin[ing], based on a comparison between the practice profile for the particular practice and the set of criteria, whether the particular practice qualifies as a best practice of the enterprise and, if the particular practice so qualifies, assigning a best practice maturity level to the particular practice” as recited in Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claims 17 and 28 and their dependent claims.

III. The Separately-Rejected Dependent Claims are Allowable

The Examiner rejects Claims 11, 24, and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Balz*. Applicants respectfully traverse these rejections.

Dependent Claims 11, 24, and 35 depend from independent Claims 1, 17, and 28, respectively, which Applicants have shown above to be allowable over *Balz*. Thus, dependent Claims 11, 24, and 35 are allowable at least because they depend from allowable independent claims. Additionally, dependent Claims 11, 24, and 35 recite further patentable distinctions in addition to those discussed above with regard to independent Claims 1, 17, and 28. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 17, and 28, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicants do not admit that the proposed

modifications are possible or that the Examiner has provided an adequate reason for modifying the reference in the manner proposed by the Examiner.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 11, 24, and 35.

The Examiner rejects Claims 9, 12, 16, 23, 25, 27, 34, 36, and 38 under 35 U.S.C. § 103(a) as being unpatentable over *Balz* in view of U.S. Patent Application Publication No. 2003/0004766 by Sandoval et al. ("*Sandoval*"). Applicants respectfully traverse these rejections.

Dependent Claims 9, 12, and 16 depend from independent Claim 1, dependent Claims 23, 25, and 27 depend from independent Claim 17, and dependent Claims 34, 36, and 38 depend from independent Claim 27. Applicants have shown independent Claims 1, 17, and 28 to be allowable over *Balz* for the reasons discussed above. The Examiner does not allege that *Sandoval* makes up for the above-discussed deficiencies of *Balz*. Thus, dependent Claims 9, 12, 16, 23, 25, 27, 34, 36, and 38 are allowable at least because they depend from allowable independent claims. Additionally, dependent Claims 9, 12, 16, 23, 25, 27, 34, 36, and 38 recite further patentable distinctions over the proposed *Balz-Sandoval* combination proposed by the Examiner. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 17, and 28, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicants do not admit that the proposed combination of references is possible or that the Examiner has provided an adequate reason for combining or modifying the references in the manner proposed by the Examiner.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 9, 12, 16, 23, 25, 27, 34, 36, and 38.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

Although no fees are believed due at this time, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Chad D. Terrell', is written over a horizontal line.

Chad D. Terrell

Reg. No. 52,279

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